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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,740	04/26/2001	Yoshiharu Kobayashi	YAMAP0503US	5367

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EXAMINER

JEAN PIERRE, PEGUY

ART UNIT	PAPER NUMBER
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2819

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,740

Applicant(s)

KOBAYASHI ET AL.

Examiner

Peguy JeanPierre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-36 is/are allowed.
- 6) ☒ Claim(s) 37-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 37-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 37, line 6, the term "data" is confusing and broad. It may refer to "scramble data", "scrambled data" (in the claims) or "demodulated data", "output data" (in the specification).

Applicant argues that the term "data" refers to the input data. It is suggested that the term "data" must be replaced by --input data-- whenever it deems necessary in the claims to avoid any confusion.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3. Claims 37-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Murakami et al. (USP 5,671,226).

Murakami et al. disclose in Figure 20A a method for scrambling data that comprises the steps of generating a pseudo random number sequence (73a) based on value of data 72a; generating scrambled data (76) by performing a logical operation on the pseudo random number sequence and the data (71) (see col. 2, line 59 to col. 3 line 3). The scrambled data may be recorded on a recording medium (see col. 6, line 1). In addition, Murakami et al. disclose a plurality of fixed length packets, from the information source, to be multiplexed that represents a plurality of data units (see col. 6, lines 30-42); further randomly determined scramble data or any data is well known in the art.

Response to Arguments

4. Applicant's arguments with respect to claims 37-42 have been considered but are not persuasive.

The 112 rejection has been maintained. Applicant argues that "said data" in line 6 represents the --scrambling-- data recited in the preamble. If it is so, it suggested that the word data be replaced by scrambling data in line 6. Claim in an application must be clear and it is our responsibility to make it clear to avoid any misinterpretation.

As per claim 1, Applicant argues that the "scramble data itself has a value that is randomly determined". This limitation is not clearly described in the specification. The burden is shifted to Applicant to point out unequivocally, in the specification this particular limitation. Initially and currently, the pseudo random number sequences are "random numbers" that have value that are randomly determined. For instance, the

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drawings of Figure 12, illustrates an initial bit pattern (53) whose output is connected to a pseudo random number generator (52); and exclusive or gate circuit (50) performs a logical operation on the data to be scrambled and the pseudo random number sequences. Nothing in the drawing suggests that the scrambling data has a value that is randomly determined (see col. 26 lines 40-49 and col. 26, line 66 to col. 27, line 7).

Applicant argues that the same initial value in the cited reference is used to generate a pseudo random number sequence. It is to be noted that throughout the specification of the present application the initial value (data) is used to generate the pseudorandom number sequence (see col. 23, line 10; col. 26, line 66 to cite a few). It is also clear that the initial value represent the beginning of a pattern and that more initial values or other values can be used to generate the pseudo random number sequences.

Allowable Subject Matter

5. Claims 1-36 are allowed.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yamamoto (USP 5,432,853) and Hsu et al. (USP 6,408,073) disclose systems for encoding and decoding scrambled data.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peguy JeanPierre whose telephone number is (703) 308-1968 and fax number is (703) 746-4034. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956. The Group fax number is (703) 308-7722.


PEGUY JEANPIERRE
PRIMARY EXAMINER
April 23, 2003